

REMARKS

This Amendment is submitted in response to the Office Action dated December 31, 2002. In the Office Action, the Patent Office rejected Claims 1-8 and 21. More specifically, the Patent Office rejected Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over *Main* (U.S. Patent No. 5,618,064) in view of *Petkovsek* (U.S. Patent No. 5,697,648). The Patent Office also rejected Claim 8 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Petkovsek* and further in view of *Coats et al.* (U.S. Patent No. 5,624,069). Finally, the Patent Office rejected Claim 21 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Coats et al.*.

Applicant notes with appreciation that the Patent Office indicated that Claims 9-16 are allowable.

By the present amendment, Applicant amended Claim 21. Applicant submits that the amendment overcomes the rejections by the Patent Office for the reasons that follow and that the application is now in condition for allowance. Notice to that effect is requested.

As to the rejection of Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Petkovsek*, Applicant submits that the rejection of Claims 1-7 is improper for the reasons that follow.

Claim 1 requires a mailing assembly for use in connection with the non-domestic delivery of a mailpiece holding contents for delivery thereof having a backing sheet that forms a

compartment to be adhered to the mailpiece. Claim 1 further requires a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. The mailing form is variably printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Claim 1 also requires a mailing form inserted into the compartment to effect non-domestic delivery of the mailpiece. Claim 1 further requires a receipt card having no adhesive backing wherein the receipt card is removably attached to the backing sheet. Claim 1 also requires the receipt card to be detachably connected to the mailing form.

On the contrary, *Main* merely teaches a packing slip and shipping label for use on a package. The packing slip has a front side having an area where a destination is contained and printed. The shipping label has a top side and a bottom side. The bottom side is adhesively coated and adhered to the backing slip. The shipping label is removed from the back side of the packing slip, and the packing slip is folded such that the destination is visible. The shipping label is affixed to the package via an adhesive coating adhered to the shipping label.

However, *Main* does not teach or suggest a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive as required by Claim 1 of the present invention. Further, *Main* does not teach or suggest a mailing form that is variably

printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Still further, Claim 1 requires a receipt card without an adhesive backing wherein the receipt card is removably attached to the backing sheet. The Patent Office stated that *Main* does not disclose a mailing form having an adhesive mailing label and a non-adhesive receipt card, wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1.

The Patent Office alleges that *Petkovsek* discloses in Figure 4 and Figure 5, a mailing form having a removable adhesive mailing label and a non-adhesive card, wherein the card is removably attached to the backing sheet and is detachably connected to the mailing label.

Petkovsek teaches a system for mailing an article requiring special services and a method for forming a mailpiece having an interior for carrying an article requiring special services. The system includes an integrally formed envelope and form constructed from a single sheet and folded and sealed to form an envelope and an attachment having a return postcard.

Contrary to the assertions of the Patent Office, *Petkovsek* does not teach or suggest a mailing form having a removable adhesive mailing label, and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label. More specifically,

Petkovsek "illustrates the return postcard 18 in its position attached to the backside of the top half 14 of the assembly by the adhesive 60 from sections 54, 56 removed from the backsides of the sections 20, 22." Therefore, neither *Main* nor *Petkovsek* teach a mailing form having a removable adhesive mailing label, and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1 of the present invention.

Moreover, a person of ordinary skill in the art would never have been motivated to modify *Main* and *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time

the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Main* and *Petkovsek* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Main* with *Petkovsek* to produce the claimed invention as defined by Claims 1-7. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Applicant respectfully submits that Claims 1-7 distinctly define the present invention from *Main* and *Petkovsek*, taken singly, or in combination.

As to the rejection of Claim 21 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Coats et al.*, Applicant amended Claim 21. Applicant submits that the rejection of Claim 21 has been overcome by the amendment and for the reasons that follow.

Claim 21 requires a mailing assembly for use in connection with non-domestic delivery of a mailpiece having a backing sheet wherein the backing sheet forms an envelope having a

compartment wherein the backing sheet is adhered to the mailpiece. Claim 21 further requires a mailing form removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts. Claim 21 requires that each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece wherein at least one of the plurality of sub-parts is inserted into the compartment. Still further, Claim 21 requires an adhesive layer disposed on the backing sheet wherein the envelope formed from the backing sheet is formed via the adhesive layer on the backing sheet.

The Patent Office alleges that *Main* discloses, in Figure 1 and 2, a mailing assembly having all of the elements as disclosed in Claim 1. However, the Patent Office stated that *Main* does not disclose a backing sheet "wherein the backing sheet forms an envelope having a compartment, and wherein the mailing form is sub-divided into a plurality of printed sub-parts." The Patent Office further alleges that *Coats et al.* disclose a mailing assembly having a backing sheet forming an envelope formed via the adhesive layer and adhered to a mailing form having sub-parts.

However, *Coats et al.* merely teach an envelope assembly that attaches to a mailpiece and receives various documents. *Coats et al.* do not teach a mailing form removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts and further wherein at least one of

the plurality of sub-parts is inserted into the compartment as required by Claim 21. *Coats et al.* merely teaches an envelope assembly that receives external documents placed into the envelope assembly.

The Patent Office provided absolutely no teaching whatsoever as to why one having ordinary skill in the art would have modified *Main* with the teachings of *Coats et al.* as applied by the Office Action in the rejection under 35 U.S.C. §103(a) by providing a mailing assembly as required by Claim 21 of the present invention.

Moreover, a person of ordinary skill in the art would never have been motivated to combine *Main* with *Coats et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time

the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Main* and *Coats et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Main* with the teaching of *Coats et al.* to produce the claimed invention as defined by Claim 21. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Applicant respectfully submits that amended Claim 21 distinctly defines the present invention from *Main* or *Coats et al.*, taken singly, or in combination.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claim 8 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Petkovsek* and further in view of *Coats et al.*, Applicant submits that the rejection has been overcome for the same reasons set forth with respect

to Claim 1. More specifically, none of *Main*, *Petkovsek* or *Coats et al.*, taken singly or in combination, teach or suggest a mailing form having a removably adhesive mailing label, and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachable connected to the mailing label. Applicant submits that Claim 8 is dependent on Claim 1. Because the references fail to teach the limitations of Claim 1, Applicant respectfully submits that the rejection to Claim 8 has been overcome. Notice to that effect is requested.

Claims 2-8 depend from Claim 1. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements of Applicant's mailing assembly.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected.

If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue.

Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



(Req. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Ave.
Chicago, IL 60647
(773) 772-6009
ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT AFTER FINAL** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, Box AF, Washington, D.C. 20231 on Feb 28, 2003.



Brian M. Mattson

VERSION WITH MARKS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend Claim 21 as follows:

21. A mailing assembly for use in connection with non-domestic delivery of a mailpiece, the assembly comprising:

a backing sheet wherein the backing sheet forms [is capable of forming] an envelope having a compartment wherein the backing sheet is adhered to the mailpiece;

a mailing form removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts wherein each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece wherein at least one of the plurality of sub-parts is inserted into the compartment; and

an adhesive layer disposed on the backing sheet wherein the envelope formed from the backing sheet is formed via the adhesive layer on the backing sheet.